

Exhibit C

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

EMERSON ELECTRIC CO.,)
)
Plaintiff,)
)
v.) C.A. No. 17-1846-LPS-JLH
)
EMERSON QUIET KOOL CO. LTD., and) **REDACTED -**
HOME EASY LTD.,) **PUBLIC VERSION**
)
Defendants.)

LETTER TO THE HONORABLE JENNIFER L. HALL FROM ADAM W. POFF

Dated: September 11, 2020

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September 11, 2020

Via ECF Filing

The Honorable Jennifer L. Hall
United States District Court for the District of Delaware
J. Caleb Boggs Federal Building
844 North King Street
Wilmington, DE 19801

**REDACTED - PUBLIC
VERSION**

Re: *Emerson Electric Co. v. Emerson Quiet Kool Co. Ltd. and Home Easy Ltd.*, No. 17-cv-01846-LPS-JLH, D. Del.

Dear Judge Hall,

We write on behalf of Plaintiff Emerson Electric Co. (“Emerson Electric”) to defend the common interest privilege (“the Privilege”) that the United States District Court for the District of New Jersey confirmed, under identical facts and judicial support as presented here, in a suit brought against these Defendants.¹ In the New Jersey action, Judge Kiel, having considered the same arguments Defendants make here, denied Defendants’ motion to compel, ruling “that [Emerson Radio] and Emerson Electric Co. share a common interest in preventing actual or likely confusion by the alleged improper actions of defendants, and therefore, the Privilege applies.” Ex. 1. Defendants’ attempt at a second bite at the proverbial apple must fail.

Emerson Radio Corp. (“Emerson Radio”), the plaintiff in the New Jersey suit, and Emerson Electric each seek redress for Defendants’ infringing use of the mark EMERSON QUIET KOOL. Emerson Electric and Emerson Radio share a common legal interest in stopping Defendants’ infringement and entered into a Common Interest Agreement. Ex. 2. Communications shared pursuant to the Common Interest Agreement are the subject of Defendants’ motion to compel. Those communications are protected under both the Privilege and the work product doctrine.

Defendants contend that two rights holders seeking to enjoin the same conduct by the same defendants is somehow improper. Defendants offer no substantiation for their claim, nor any justification for setting aside the Privilege. Defendants seek readjudication here of the New Jersey court’s recognition of the Privilege based on the same arguments and law. Ex. 3. As noted above, Judge Kiel denied Defendants’ motion to compel, ruling “that [Emerson Radio] and Emerson Electric Co. share a common interest in preventing actual or likely confusion by the alleged improper actions of defendants, and therefore, the Privilege applies.” Ex. 1. Judge Kiel directed Emerson Radio to prepare and submit a privilege log “setting forth all documents

¹ *Emerson Radio Corp. v. Emerson Quiet Kool Co. Ltd. and Home Easy Ltd.*, No. 2:17-cv-05358-SDW-LDW (D. N.J.).

Further, although Emerson Electric and Emerson Radio use different EMERSON marks on different products, this does not preclude a shared *legal* interest in protecting their respective trademarks against Defendants infringement.

Defendants cite the fact that there are two suits as justifying their assertion that Emerson Electric and Emerson Radio are “colluding” with each other “presumably to drive Defendants out of business.”⁵ Defendants lack any basis for this speculation, and the fact that both parties exercise their First Amendment right to assert their respective trademark rights is not a basis to conclude that the common interest does not apply.⁶ Quite simply, there is nothing improper about both entities holding Defendants accountable for their unlawful conduct.

Finally, the documents at issue are also designated as attorney work-product. Defendants bear the burden of establishing that a “substantial need” for the documents and/or a waiver of the privilege. *See* FRCP 26(3)(A)(ii); *Louisiana*, 253 F.R.D. at 311 (“The burden of establishing waiver of the work product doctrine falls on. . . the party seeking to establish waiver”). Defendants do not address the work-product designation and have not articulated any need for these documents or any harm that would result from non-disclosure.⁷ Defendants’ protests of “collusion” are not tied to any recognized legal theory, and, do not justify overriding the work-product designation.

Emerson Electric requests this Court adopt Judge Kiel’s approach recognizing that Emerson Electric and Emerson Radio share a common legal interest in stopping Defendants’ infringement and upholding the Privilege. Emerson Electric has provided a privilege log⁸ identifying the documents withheld on the basis of the Privilege, consistent with the ruling in the New Jersey case. Adopting the same approach here serves the interest of judicial consistency and conserves judicial resources by avoiding an *in camera* review.⁹ Defendants have failed to meet their burden demonstrating that production of privileged information is necessary and/or that the common interest privilege does not apply. Defendants’ motion should be denied.

negate the effect of the legal interests in establishing a community of interest.” *MobileMedia Ideas LLC v. Apple Inc.*, 890 F. Supp. 2d 508, 515 (D. Del. 2012)(citations removed).

⁵ By Defendants’ logic, the mere formation of a joint defense group, which is common in cases before the Court, would seemingly be an act of improper collusion.

⁶ Defendants question “why the two parties chose to file two separate cases,” however, Defendants have not raised a joinder issue in either case. Emerson Electric submits joinder is improper because both parties have separate claims based on their respective rights.

⁷ Defendants’ failure to challenge Judge Kiel’s order suggests a lack of substantial need for the documents at issue.

⁸ Defendants raise alleged inconsistencies in the documents reflected on Emerson Electric’s and Emerson Radio’s respective privilege logs. Yet, any inconsistencies do not warrant a finding of no community of interest. Moreover, the differences undercut Defendants’ claim of “collusion”- if Emerson Electric and Emerson Radio were “colluding,” one would expect identical logs.

⁹ Judge Kiel considered briefing and oral argument, but did not review the documents *in camera*.

Sincerely,

/s/ Adam W. Poff

Adam W. Poff (No. 3990)

cc: All counsel of record (by email)